

Amendment - 09/759,103
Response to Final Office action mailed June 22, 2004

REMARKS

The undersigned attorney for applicants thanks Examiner Lastra and Primary Examiner James Myhre for the helpful interview conducted on August 31, 2004. The changes to the claims are in accordance with the discussions held. An RCE is being concurrently submitted.

As a preliminary matter, and as mentioned in the March 26, 2004 Amendment, the patent office is reminded that Attorneys for Applicants changed earlier in the year. It is requested that the Attorney docket number be changed from "10567-003" to the new Attorney Docket No. of "P166 1010.1".

In the final office action mailed June 2, 2004, the Examiner rejected claim 1 under 35 USC § 112, 2nd ¶ on grounds that "providing the user" and "product or service for the user" lacked antecedent basis. As agreed upon during the interview, the original language of claim 1 is acceptable since the preamble of claim 1 mentions "a user".

Claim 10 was rejected under USC § 112, 2nd ¶ on grounds that the phrase "may be" in the phrase "where the product may be purchased" was indefinite. As suggested by Examiner Myhre during the interview, this language has been amended to read "which sells the product".

Also in response to a suggestion by Examiner Myhre, claims 1, 10 and 15 have further been amended to change the language "based on the pseudo-random outcome" to --in response to a winning pseudo-random outcome--, so as to clarify that not *any* pseudo-random outcome will result in a win.

As to the merits over the prior art, claims 1, 2, 7, 8, 10, 12, 13, 15, 17 and 18 were rejected under 35 USC § 102 as being anticipated by USP 6,443,843 to *Walker*, and claims 9, 14 and 19 were rejected under 35 USC § 103(a) being unpatentable over *Walker*. Claims 3-5 were rejected under 35 USC § 103(a) as being unpatentable over *Walker* in view of USP 6,331,143 to *Yoseloff*, and claims 6, 11 and 16 were rejected as being unpatentable over *Walker* in view of USP 6,183,366 to *Goldberg* and further in view of USP 6,553,178 to *Abecassis*.

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Rejection under 35 USC 102/Amendments to claims 1, 10 & 15

Independent claims 1, 10 and 15 have been amended to recite that the user may play the game of chance and win a prize “without first making any payment.” In the embodiments disclosed by *Walker* in Figs. 8 – 10, either a fee or a product payment must be received from the user before the game can be played.

Walker does not disclose at least two other aspects of the claimed invention. Claims 1², 10³ and 15⁴ all call for (1) receiving electronic signals representing . . . (search parameter(s)) descriptive of a product (or service); and (2) transmitting information about a dealer of that product or service, along with associated prices. This is consistent with the intent of the present invention, which is directed to a web-site at which users may search for a product, be presented with information about dealers of those products along with the prices charged by those dealers, and be given an opportunity to win the product.

Walker does not disclose receiving any kind of “search parameter”. Indeed, a full text search of the *Walker* patent disclosure does not turn up even a single instance of the word “search”. Instead, *Walker* allows the user to *select* a product by selecting a displayed hyperlink corresponding to the product (col. 4, ll. 6 – 11).

It is further noted that *Walker* does not transmit information about a multiplicity of dealers offering the product, as recited in claims 1 and 15. *Walker* does not teach a system that shows the prices of competing dealers, but rather is directed to a system that shows the price of a selected product associated with a single dealer. Therefore, claims 1, 10 and 15 are not anticipated by *Walker*.

² Specifically, claim 1 recites “transmitting electronic signals representing dealers in the product or service and associated prices”

³ Specifically, claim 10 recites “transmitting electronic signals representing at least one product, a price of the product and a third-party dealer of the product”

⁴ Specifically, claim 15 recites “transmitting electronic signals representing a plurality of different dealers and associated prices charged by each of said different dealers for products identified in response to said at least one search parameter”

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Amendment to the Specification

The specification has been amended to summarize what is evident from the immediately preceding two paragraphs, and recite language that appears in amended claims 1, 10 and 15. It is believed that no new matter has been introduced by these changes.

Potential Issue of New Matter Mentioned in Examiner's "Response to Arguments"

On page 10 of the final office action, the Examiner said that "[B]ecause Applicant's specification is silent about fees, the Examiner would consider the added amended feature of "without paying a fee" as new matter". The present amendment changes this language to "without first making any payment." It is submitted that there is support for this language in the original specification text and figures. In this regard, it is first noted that Figs. 2a and 2b, which illustrate flowcharts pertaining to an embodiment of the present invention do not mention or allow for the user to make any payment to play the game, whether it be in the form of a wager, a fee or purchase price of a product. The original specification describes Figs. 2a and 2b as follows:

[0031]The use of the system is schematically illustrated in FIGS. 2a and 2b. To begin, the user navigates to the home Web page for the system 201. From the home page, the user may attempt to win cash 202, browse for an item or service to attempt to win 203, or search for an item or service to attempt to win using a search engine interface 204. After the user locates an item by browsing 203 or searching with search terms and restrictions 204, 205, the system retrieves a list of matching items or services available for sale on third-party Web sites along with pricing and other information 206 and displays the information to the user in a dynamically generated Web page 207. The user may then select the particular offer they desire 208 and either buy the offered item or service from the offering Web site 209 or attempt to win it using the game aspect of the invention 210.

[0032]If the user attempts to win the offered item or service 210, the system determines whether the user has an existing PIN number 211 for use in signifying the outcome of a game of chance. If not, the user may select a PIN by entering a number 212, or having a pseudo-random PIN generated for the user 213. When the user has a PIN, the system calculates a probability of winning the selected item or service based on factors including the items cost, the current prize budget available, and the revenues derived from this user 214. The system then generates

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a random trial having the calculated probability of occurrence 215. If the trial results in a win for the user, the system displays the user's PIN as an outcome number 217 and causes the selected item to be purchased for the user 218. If the trial does not result in a win for the user, an outcome number not equal to the user's PIN is displayed 219.

It is thus submitted that the foregoing description details an embodiment in which the user can win the product without first making any payment and so there is support for the amended language. Moreover, these figures and passages are in complete contrast to *Walker's* teachings as illustrated in Figs. 8 - 10, which include the steps "Receive Fee" (steps S840, S940), and "Receive Payment for Product" (step S1020), before a customer is allowed to play a game (steps S850, S950, S1050, respectively).

In view of all of the foregoing, it is submitted that the present amendments to claims 1, 10 and 15 do not introduce new matter into the application.

Walker Teaches Away from Playing and Winning "Without First Making Any Payment"

In anticipation of the Examiner arguing that one can modify *Walker* to not collect any kind of payment to play and win a product, it is first noted that all of *Walker's* embodiments call for receiving some kind of payment – either a fee or purchase price of a product before the user is allowed to play to win anything. Furthermore, all of *Walker's* *independent* claims either call for receiving a fee or basing a price, a probability or some other parameter on a fee that was paid. In view of these two factors, it is submitted that *Walker teaches away* from a system that permits a user to play a game and win "without first making any payment", as recited in the independent claims.

In one embodiment described by *Walker*, the customer is credited the entire received fee if the outcome is a losing outcome (col. 2, ll. 10 – 12). *Walker* further teaches that the inventive system will be attractive to customers because a participating customer will either win the product or be no worse off than if the game was not played. This teaching clearly indicates that the customer will be credited with the fee he has paid, only if the outcome is a losing outcome. Conversely, if the outcome is a winning outcome, the customer receives the product for free, but does not have his fee for playing the game credited to him. *Walker* further teaches, at col. 2, lines

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18 – 26, that the fee can also be credited to a sale price of the product if the outcome is a losing outcome. *Walker* assumes that the customer intends to buy the product, regardless of the game outcome, which means the customer experiences no loss as a result of playing the game, even if the resulting outcome is a losing outcome. But *Walker* adds that in a case in which the customer does not purchase the product after playing the game, the retailer earns a fee as additional revenue source.

In view of *Walker*'s specification, and further in view of the fact that all of *Walker*'s claims either call for receiving a fee or basing a price or other parameter on a fee, it is submitted that *Walker* teaches away from a system that permits a user to play a game and win "without first making any payment", as recited in the independent claims.

Rejection under 35 USC 103(a) of Claims 9, 14 & 19 as being unpatentable over Walker

In formulating the rejection of these claims, the Examiner argued that *Walker* discloses the recited method. The Examiner's rejection is traversed because *Walker* does not disclose the formula recited in the pending claims 9, 14 and 19.

Between Col. 14, line 35 and Col. 16, line 31, *Walker* discloses a number of formulas for calculating various parameters for determining the probability of a winning outcome. However, none of these results in the formula recited in these claims. The recited probability of claims 9, 14 and 19 includes a product of three specific probability measures ($P_a * P_t * P_m$), scaled by the number of users N, PLUS an additional probability that varies with the user's behavior. Nothing in *Walker* suggests anything of the sort. It is submitted that the Examiner has failed to make a prime facie case of unpatentability of at least claims 9, 14 and 19. Should the Examiner maintain this rejection, the Examiner is kindly asked to show how, upon viewing *Walker*, one of ordinary skill in the art would arrive at the recited formula.

New Claims 20 – 28

New dependent claim 20 recites that the "electronic signals representing the associated prices charged by each of said different dealers, represent the prices charged on said each of said different dealers' own web sites. Support for this language comes from the first full paragraph

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of the Detailed Description which reads, in pertinent part, “[t]he system shown in FIG. 1 retrieves item or service and price information from third-party web sites offering items for sale and allows the user to search for the lowest prices for an item or service.” (emphasis added). It is therefore submitted that pending claim 20 does not introduce new matter in the application.

New claims 21 – 30 claim other aspects of the present invention and are fully supported by the specification. Limitations recited in claim 1, 10 and 15 and distinguished in the preceding remarks from the teachings of *Walker* are also recited in similar or related form in new independent claims 21 and 22.

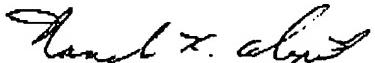
With respect to all claims not specifically mentioned, it is submitted that these are patentable not only by virtue of their dependency on their respective base claims and any intervening claims, but also for the totality of features recited therein.

Reconsideration of the application is requested. Claims 1-30 are believed to be in allowable form and define over the prior art of record. An early notice of allowance is requested so that the application may proceed to issue.

A separate Request for Continued Examination is being submitted herewith. The Commissioner is authorized to charge any such fee to Womble Carlyle's Deposit Account No. 09-0528 for any other fees required by this response.

Respectfully Submitted,

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Nanda K. Alapati (Reg. No. 39,893)
703-394-2216
USPTO Customer No. 26158
Womble, Carlyle, Sandridge & Rice
P.O. Box 7037
Atlanta, GA 30357-0037